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| 09/092,488 | 06/05/1998 | TEDDY C. JOHNSON | 10980822-1 | 6145 |

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT PAPER NUMBER

3621

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/092,488
Filing Date: June 05, 1998
Appellant(s): JOHNSON, TEDDY C.

Robert W. Nelson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief contains a statement that there are no other appeals and interferences that relate to the Application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 11; claims 2, 3, and 6; and claim 7 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-3, 6, 7, and 11 appears on pages 1-3 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 11, lines 4 and 14, "(36)" and "(52)" should be deleted.

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(9) Prior Art of Record

| | | |
|--------------|-------------|---------|
| 5,832,527 | KAWAGUCHI | 11-1998 |
| 6,185,619 B1 | JOFFE ET AL | 2-2001 |

The disclosed prior art (FIG. 1)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 103

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 1-3, 6, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosed prior art in view of Joffe et al (Joffe hereinafter: US PAT. 6,185,619 B1) and Kawaguchi (US PAT. 5,832,527).

The disclosed prior art (Fig. 1) shows a system having (a) a host machine for running a plurality of processes (i.e., Web server, FTP server, and customer database), the host machine residing an unsecured side of a firewall (i.e., an external side of the firewall); and (b) a filing storage system accessible by the host machine having a storeroom area and a customer account.

Re claims 1, 7, and 11: The disclosed prior art does not show the following features:

(1) a plurality of host machines for running a plurality of processes located an unsecured side of a firewall;

(2) at least one secure communication link between the plurality of host machines.

(3) hard file links comprising pointers to files between the storeroom area and the customer account area; and

(4) at least one secured host machine located on the secured side of the firewall, wherein the secured host machine comprises a customer account database which is accessible by at least one of the plurality of host machines across a second secure communication link through the firewall.

However, these differences between the subject matter sought to be patented and the disclosed prior art do not render the claimed construction patentable for the following reasons.

(1) Joffe discloses the use of a plurality of servers for running a plurality of processes (see column 2, lines 8-9) to solve “The problems of latency and bandwidth constraints” (see column 1, lines 51-53). Thus, It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plurality of host machines for running a plurality of processes as disclosed by Joffe to solve “The problems of latency and bandwidth constraints”. Further, It would have been within the level ordinary skill in the art at the time the invention was made to employ a plurality of host machines for running a plurality of processes, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

(2) It is well-known and fundamental practice in the art to employ secure communication links (e.g., cryptography) to protect against unauthorized access, operation or use of any web site, server or network system, and it would have been common sense to use secure communication links to any web site, server network including the host machines as claimed as desired.

(3) Kawaguchi teaches the use of hard link having a pointer to provide a file management system that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects. Thus, it would have been within a level of ordinary

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skill in the art to modify the disclosed prior art by adopting the teaching of Kawaguchi (i.e., linking files) to provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects.

(4) As stated supra, Joffe discloses the use of separate host machines for running a plurality of processes (see column 2, lines 8-9) to solve "The problems of latency and bandwidth constraints" (see column 1, lines 51-53). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a separate host machine having a customer account database to solve "The problems of latency and bandwidth constraints". Further, It would have been within the level ordinary skill in the art at the time the invention was made to employ a separate host machine for a customer account database, since it has been held that constructing a formerly integral structure (i.e., a host machine having Web server, FTP server and a customer database) in various elements (i.e., a host machine having Web server, a host machine having FTP server, and a host machine having a customer database) involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Still further, one of the basic problems in the art is to keep the customer account database (which generally contains sensitive information, i.e., credit card numbers, phone numbers and addresses) secure, and it would have been common sense to employ a secured host machine located on the secured side of the firewall to enhance the security of the customer account database. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the host machine having the customer account database at any desirable location including the claimed location to enhance the security of the

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customer account database, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Moreover, the customer account database (which is used for authorizing the customer to a specific web site and charging the fee) must be accessible by at least one of the plurality of host machines across a second secure communication link through the firewall.

Re claims 2, 3, and 6: None of the cited prior art explicitly discloses the use of various claimed secure communication links (i.e., protocol recited in claim 2, DES, or tobj protocol). However, these are well-known protocols used for secure communication, and nothing unobvious is seen to have been involved simply having employed these well-known protocols for transferring data over the Internet to provide the security to the data transfer.

(11) Response to Argument

- In response to The Appellant's argument that there is "NO MOTIVATION TO COMBINE"

The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the

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modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, as stated supra, Joffe clearly provides motivation to use a plurality of servers for running a plurality of processes (see **column 2, lines 8-9**) to solve **"The problems of latency and bandwidth constraints"** (see **column 1, lines 51-53**) and Kawaguchi clearly teaches the use of hard link having a pointer to **provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects.**

The Appellant stated that the inventions of Joffe and Kawaguchi are directed to much different objectives and that there is no motivation for a combination. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985), and the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of

the motivating force which would impel one skilled in the art to do **what the patent applicant has done** ", reading the quotation in context it is clear that while there must be motivation to make the claimed invention, **there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.**

Further, by citing MPEP and *In re Sang Su Lee*, the Appellant implied that The Examiner relied on "subjective belief and unknown authority" for motivation to combine the cited references. However, as stated supra, the Examiner clearly provided the objective reason for the combination, i.e., **to solve "The problems of latency and bandwidth constraints"** (see column 1, lines 51-53 of Joffe) and to provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects (column 1, lines 51-53 of Kawaguchi). Thus, the Examiner clearly relied on his motivation based on objective teaching in the prior art and known authority.

- In response to appellant's argument that "COMBIANTION DOES NOT DISCLOSE ALL THE ELEMENTS OF CLAIM 1"

The Board's attention is directed to the fact the rejections are based on combinations of references and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, the claimed elements would have been obvious for the reasons stated supra and the obviousness of rearranging the elements (i.e., to locate the host machine having the customer account database at any desirable location including the claimed location to enhance

the security of the customer account database) is based on the legal decision (i.e., *In re Japikse*, 86 USPQ 70). In MPEP § 2144, it states:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection. (emphasis added)

However, Appellant has not demonstrated the criticality of a specific limitation (i.e., to locate the host machine having the customer account database at any desirable location including the claimed location) beyond the well-known motivation in the art (i.e., to enhance the security of the customer account database) which would have been obvious to one of ordinary skill in the art. Thus, it would be appropriate to rely solely on case law (i.e., *In re Japikse*, 86 USPQ 70 and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) as the rationale support the examiner's obviousness rejection.

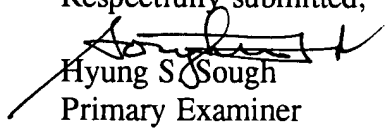
In response to Appellant's request "that the Examiner provide a reference that discloses the claimed protocol in conjunction with the limitations of claim 1." and request to provide "any references that disclose the elements of claim 7 with the limitations of claim 1", The Board's attention is directed to the fact that Appellant has never seasonably challenged that the well known statement, i.e., the use of claimed secure communication links (i.e., protocol recited in claim 2, DES, or tobj protocol) for secure communication, and the rejection is under

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35 U.S.C. § 103 which is used for a rejection when there is no single reference that suggests or discloses all the elements claimed.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Hyung S. Sough
Primary Examiner
Art Unit 3621

shs

June 13, 2002

Conferees

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